



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Martin L. Hage
S rial No. 09/305,586
Filed: May 5, 1999
Title: TEMPORARY PROTECTIVE LAYER ON POLYMERIC ARTICLES

Examiner: A. Johnstone
Group Art Unit: 1733
Docket No. 589.015US1

BOX: AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

The following documents are hereby submitted:

- ☒ Amendment and Response (11 pages)
- ☒ Copy of IPER confirming documents cited in the Search Report (9 pgs)
- ☒ Transmittal Sheet
- ☒ Return postcard

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If an additional fee is required due to changes to the claims, the fee has been calculated as follows:

CLAIMS AS AMENDED						
	(1) Claims Remaining After Amendment		(2) Highest Number Previously Paid For	(3) Present Extra	Rate	Fee
TOTAL CLAIMS	23	-	21	2	x 18.00 =	\$36.00
INDEPENDENT CLAIMS	2	-	3	0	x 84.00 =	\$00.00
[] MULTIPLE DEPENDENT CLAIMS PRESENTED						\$0.00
TOTAL						\$36.00

Authorization is hereby given to withdraw the amount of \$36.00 from Deposit Account Number 50-1391. Any further charges deemed necessary are hereby authorized to be deducted from Deposit Account Number 50-1391.

MARK A. LITMAN & ASSOCIATES, P.A.
York Business Center, Suite 205, 3209 W. 76th St.
Edina, MN 55402 (952-832-9090)

By:
Atty: Mark A. Litman
Reg. No. 26,390

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described her in, ar being deposited in th United States Postal S rvce, as first class mail, with sufficient postage, in an nvelope addressed to: Assistant Commissioner for Pat pts, Washingt n, D.C. 20231 on July 8, 2002..

Mark A. Litman
Name

Signature

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INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

Mark A. Litman
 Mark A. Litman & Associates, PA
 York Business Center, Suite 205
 3209 West 76th Street
 Edina, Mn 55435
 ETATS-UNIS D'AMERIQUE

NOTIFICATION OF TRANSMITTAL OF
 THE INTERNATIONAL PRELIMINARY
 EXAMINATION REPORT

(PCT Rule 71.1)

Date of mailing
 (day/month/year)

14.08.01

Applicant's or agent's file reference
 589.015WO1

IMPORTANT NOTIFICATION

International application No.
 PCT/US00/05219

International filing date (day/month/year)
 29/02/2000

Priority date (day/month/year)
 05/05/1999

Applicant
 VISION-EASE LENS INC.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary examination report and its annexes, if any, established on the international application.

REVISED VERSION

2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.

4. REMINDER

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices) (Article 39(1)) (see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the PCT Applicant's Guide.

received
 8/20/01 AM

Name and mailing address of the IPEA/



European Patent Office
 D-80298 Munich
 Tel. +49 89 2399 - 0 Tx: 523656 epmu d

Authorized officer

Werner, H



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 589.015WO1	FOR FURTHER ACTION	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)
International application No. PCT/US00/05219	International filing date (day/month/year) 29/02/2000	Priority date (day/month/year) 05/05/1999
International Patent Classification (IPC) or national classification and IPC C09D5/00		
Applicant VISION-EASE LENS INC.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.



2. This REPORT consists of a total of 4 sheets, including this cover sheet.

- ☒ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of 4 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☒ Certain observations on the international application

Date of submission of the demand 03/11/2000	Date of completion of this report 14.08.01
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d	Authorized officer Trauner, H-G 

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No.

COPY 15219

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, pages:

1-9 as originally filed

Claims, No.:

1-21 as received on 02/07/2001 with letter of 18/05/2001

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
☐ the language of publication of the international application (under Rule 48.3(b)).
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
☐ filed together with the international application in computer readable form.
☐ furnished subsequently to this Authority in written form.
☐ furnished subsequently to this Authority in computer readable form.
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages: ---
☐ the claims, Nos.:
☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/US00/05219

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(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims	1-16, 18-20, 21
	No:	Claims	17
Inventive step (IS)	Yes:	Claims	1-16, 18-20, 21
	No:	Claims	17
Industrial applicability (IA)	Yes:	Claims	1-21
	No:	Claims	

**2. Citations and explanations
see separate sheet**

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:
see separate sheet

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT - SEPARATE SHEET**

International application No. PCT/US00/05219

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Ad V

The present application does not meet the requirements of Art. 33(2) PCT.

- 1.1 US-A5,883,169 (D1) pertains to a lens wafer which has a coating on at least one surface thereof to form a peelable protective and removable film thereon. The polymer coated on said surface is soluble in a compatible solvent (column 5, lines 1-4). The present description mentions on page 3, line 20 that in D1 there is no chemical binding between the film and the surface to be protected. It seems that there is also no chemical binding between the polymeric coating and the lens surfaces of present claim 17, since said polymer coating can be removed by means of a solvent.

Thus, the subject-matter of claim 17 is anticipated by D1.

- 1.2 WO 95/23351 (D2) pertains to lens wafers coated with a removable film forming polymer (page 4, lines 10-20).

Thus, the subject-matter of claim 17 is anticipated by D2.

2. The subject-matter of any of Claims 18-20 in combination with that of Claim 17 is novel.
3. Applicant's attention is drawn to US-A-5,945,462 (D3), which may be relevant for novelty in national phases.

Ad VIII

The wording "first solvent" used in Claims 1, 3, 4, 8 and 15-18 is vague. Does the wording "first solvent" imply the existence of a second solvent?

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surface, it could not be washed out. If it could be washed out, this would require an additional step at the lamination site.

Additionally, it is to be noted that D1 uses antistatic agents in the film composition. Although this is allowable in the practice of the present invention, it is not necessary. In D1, since the resin physically adheres with sufficient weakness as to be peeled from the surface, the resin likely tends towards different hydrophilic/hydrophobic characteristics and different surface tensions. These differences tend to create triboelectric charging at the interface of the film and the lens wafer. These charges would attract particles (e.g., dust) onto the lens surface, requiring a wash step in addition to the peeling. The wash step in the claimed invention removes the protective film and cleans the lens wafer surface in a single step.

There are, therefore, three distinct reasons why the soluble film of the present invention is an improvement over the peelable films of D1 used on polymeric lens surfaces.

The claims have also been amended to recite that the first solvent-soluble or solvent dispersible film is applied "directly" to the at least one surface of the first polymeric optical element. The term "directly" is meant to define that there is direct composition-to-composition contact between the protective film and the optical element; that is, that no adhesive intervenes between the two films. If the Examiner prefers alternative language to reflect this limitation that Applicant seeks to place into the claims, Applicant would appreciate the suggestion of alternative language. Note that in the Example, a raw lens was dipped directly into the polymeric coating composition. This shows that the dispersible/soluble film can be applied directly to the lens without the use of an adhesive.

Please also note that claims 3, 4, 7, 18 and 20 are limited to aqueous solvent solubility for the protective coating, which is not shown by D1.

PLEASE AMEND CLAIMS 1 AND 21 AS SHOWN BELOW:

1. A process for manufacturing laminated polymeric optical elements comprising:
 - a) applying directly to at least one surface of a first polymeric optical element a first solvent-soluble or solvent dispersible film, wherein said first polymeric optical element is not soluble in said first solvent;

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b) removing said film from said first polymeric optical element by contacting the film with said first solvent which dissolves or disperses said film; and

c) laminating said first polymeric optical element to a second polymeric optical element to form a laminated polymeric optical element.

2. The process of claim 1 wherein said first polymeric optical element and said second polymeric optical element comprise wafer components for an ophthalmic lens.

3. The process of claim 1 wherein said first solvent comprises an aqueous liquid.

4. The process of claim 2 wherein said first solvent comprises an aqueous liquid.

5. The process of claim 1 wherein said film is applied to said first polymeric optical element by applying a liquid coating composition to said at least one surface and then drying said coating composition to form said film.

6. The process of claim 2 wherein said film is applied to said first polymeric optical element by applying a liquid coating composition to said at least one surface and then drying said coating composition to form said film.

7. The process of claim 4 wherein said film is applied to said first polymeric optical element by applying a liquid coating composition to said at least one surface and then drying said coating composition to form said film.

8. The process of claim 2 comprising:

a) applying to at least one surface of a first polymeric optical element and a second polymeric optical element a solvent-soluble or solvent dispersible film, wherein said first polymeric optical element and said second polymeric optical element are not soluble in said first solvent;

b) removing said film from said first polymeric optical element and said second polymeric optical element by contacting the film with said first solvent which dissolves or disperses said film; and

c) laminating said first polymeric optical element to said second polymeric optical element to form a laminated polymeric optical element.

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9. The process of claim 2 wherein said polymeric coating composition is selected from compositions comprising polymers selected from the group consisting of acrylic polymers, polyester polymers, polyurethane polymers, poly vinyl resins, and cellulose based polymers.
10. The process of claim 2 wherein said polymeric coating composition comprises a polymer having an acid value > 100 .
11. The process of claim 10 wherein said polymer comprises an acrylic or polyester polymer.
12. The process of claim 8 wherein said polymeric coating composition is selected from compositions comprising polymers selected from the group consisting of acrylic polymers, polyester polymers, polyurethane polymers, poly vinyl resins, and cellulose based polymers.
13. The process of claim 8 wherein said polymeric coating composition comprises a polymer having an acid value ≥ 100 .
14. The process of claim 13 wherein said polymer comprises an acrylic or polyester polymer.
15. The process of claim 1 wherein said first solvent-soluble or solvent dispersible film is applied to said lens from a solution or dispersion in a coating solvent.
16. The process of claim 15 wherein said first solvent is different from said coating solvent.
17. A polymeric ophthalmic lens blank having a polymeric coating on at least both major lens surfaces, said polymeric coating being solvent-soluble or solvent dispersible in a first solvent that will not dissolve or etch the polymeric ophthalmic lens blank.
18. The lens blank of claim 17 wherein said lens blank comprises a polycarbonate resin and said first solvent comprises an aqueous solution.
19. The lens blank of claim 18 wherein said aqueous solution comprises an aqueous solution at a pH between 8.0 and 12.0.
20. The lens blank of claim 18 wherein said aqueous solution is water.

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21. The process of claim [2] 18 wherein at least one of said wafer components for an ophthalmic lens has a surface feature on a major surface of a wafer component, said surface feature being selected from the group consisting of tabs, grooves, notches, and recessed power segments.

This response is believed to fully respond to the Written Opinion and to comply with the formal requirements of the PCT Rules. Please contact the attorney of record at 011.952.832.9090 if any correspondence would be helpful in resolving any remaining issues on the matters raised in the Written opinion. It is believed that the response has established novelty and technical advance over D1, the sole reference cited against the claims of this Application.